

### **REMARKS**

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

#### **Disposition of Claims**

Claims 1-10 were pending in this application. Claims 3 and 6 have been cancelled without prejudice or disclaimer. Claims 1 and 10 are independent. The remaining claims depend, directly or indirectly, from claim 1.

#### **Drawings**

The Applicant respectfully requests that the Examiner indicate whether the originally drawings filed with the referenced application are acceptable.

#### **Claim Amendments**

Independent claims 1 and 10 have been amended to clarify the following: (i) the application program receives a command, where the command includes at least one indexing data that indexes said at least one reference element in the list, and at least one associated configuring value to be assigned to the at least one configurable variable which is referenced by the at least one reference element as indexed by the said indexing data in the command; (ii) the initializing means initiates linking between the at least one associated configuring value and the at least one reference element; (iii) wherein the initializing means, after the link has been established, transfer the at least one associated configuring value to the at least one configurable variable using the at least one reference element; and (iv) wherein the at least one configuring variable is used to configure the at least one application program. Support for the above

amendments may be found, for example, on pages 4-6 and the corresponding figures of the originally filed specification.

In addition, dependent claims 2, 4, 5, and 7-9 have been amended to address antecedent basis issues arising from the amendment of independent claim 1. No new matter has been added by any of the aforementioned amendments.

### **Rejections under 35 U.S.C. § 103**

#### **Claims 1-3, 7, and 10**

Claims 1-3, 7, and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Admitted Prior Art (APA) in view of U.S. Patent No. 5,913,218 ("Carney"). Claim 3 has been cancelled by this reply. Accordingly, this rejection is now moot with respect to claim 3. To the extent that this rejection still applies to the pending amended claims, this rejection is respectfully traversed.

Independent claims 1 and 10, as amended, require: (i) an application that includes a list including at least one reference element and at least one configurable variable associated with the at least one reference element; (ii) a command that includes indexing data, where the indexing data references the at least one reference element in the list (for example, indexing data of 2 references the second reference element in the list); (iii) the command also includes at least one associated configuring value, where the at least one associated configuring value is associated with the indexing data; and (iv) the at least one associated configuring value is transferred to the at least one configurable variable using the at least one referencing element (as identified by the indexing data).

The following is an example of an embodiment of the invention. The following example is not intended to limit the scope of the claims. Turning to the example, Figure 4 shows a

command that includes three indexing data (*i.e.*, 1, 2, 3) and three associated configuring values (*i.e.*, GSM Application, Dial, Calling). Via the initialization means, the integrated circuit portable device, establishes a link between the reference elements in the list and the associated configuring values, and after establishing the link, transfers the associated configurable values to the appropriate configurable variable using the at least one reference element.

For example, referring to Figure 5, a link is established between reference element 1 (R1) and associated configuring value "GSM Application." After the link has been established, the associated configuring value "GSM Application" is transferred to configurable variable 1 (V1) using the at least one reference element (R1) (*i.e.*, R1 is linked to V1, such that once the associated configuring value is linked to R1, the associated configuring value may be transferred to V1).

Turing to the rejection, "[t]o establish a *prima facie* case of obviousness...the prior art reference (or references when combined) must teach or suggest all the claim limitations." (*See* MPEP §2143). The Applicant respectfully asserts that the cited references do not teach or suggest all the limitations recited in the amended claims.

Specifically, the Examiner has admitted that the APA does not teach "receiving a command that comprises at least one configurable variable, the at least one mean[s] for initializing establishing a link between the at least one value comprised in the command and the at least one reference element" (*see* Office Action mailed April 4, 2006, p. 2). Further, Carney does not teach or suggest that which the APA lacks.

In particular, the amended independent claims 1 and 10 require, in part, "a command that comprises at least one *indexing data* that indexes said at least one reference element in the list, and at least one associated configuring value to be assigned to the at least one configurable variable which is referenced by the at least one reference element as indexed by the said

indexing data in the command.” (emphasis added) Carney is completely silent with respect to a command that includes indexing data, where the indexing data is used to identify a reference element in a list of reference elements.

Specifically, Carney is limited to generating a path/filename for configuration information and then sending a request for the file, using the generated path/filename information. (*see* Carney, col. 7, 39-63). Once the requested file is received, the appropriate portion of the file is transferred to the program (*see* Carey, FIG. 3B). However, there is no indication that the file includes an index, where the index denotes a reference element in *list* maintained in an integrated circuit portable device.

In view of the above, the APA and Carney, whether considered separately or in combination, fail to teach or suggest all the limitations of amended independent claims 1 and 10. Thus, amended independent claims 1 and 10 are patentable over the APA and Carney. Dependent claims are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Moreover, as stated in MPEP §2141.01(a), all prior art relied upon by the Examiner in maintaining a 35 U.S.C. §103 rejection must be analogous art. Prior art is considered to be analogous, if the prior art is in the field of the applicant’s endeavor or is reasonably pertinent to the particular problem with which the invention is concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Carney does not qualify as analogous art under either of the aforementioned categories. Specifically, Carney is not in the applicant’s field of endeavor, as Carney is directed to configuring computer systems over a network (*See, e.g.,* Carney, Abstract), while the claimed invention is directed towards configuring various variables used by an application residing on an integrated circuit portable device (*e.g.,* a smart card).

Moreover, Carney is not relevant to the problem with which the invention is directed to solving. In particular, the claimed invention is directed to method and apparatus for programming an integrated circuit portable device without having to maintain duplicate data on the integrated circuit portable device. (See Instant Specification, p. 2, ll. 13-24). In contrast, Carney is directed to sending requests across a network, to remote systems, to obtain a specific value for a configuration parameter. (See *e.g.*, Carney, FIG. 3A and 3B). Thus, the teachings of Carney are directed to the execution of an *external* application executing on a remote network system, where the remote systems include ample memory space (*i.e.*, systems that do not include the same memory limitations as the integrated circuit portable devices recited in the claims) and allow the system to maintain an external file. Thus, because Carney requires significant memory resources, the teaching of Carney is actually inapplicable to the technical field of the claimed invention. Said another way, one skilled in the art would not look to Carney to solve the problem the claimed invention solves. In view of the above, Carney is nonanalogous art and, thus, may not be used to maintain a rejection under 35 U.S.C. §103. Accordingly, withdrawal of this rejection is respectfully requested.

#### Claims 4 and 5

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Admitted Prior Art (APA) in view of Carney and further in view of U.S. Patent No. 5,829,006 ("Parvathaneny"). Claims 4 and 5 depend from amended independent claim 1. To the extent that this rejection still applies to the amended claims, this rejection is respectfully traversed.

The Examiner has admitted that the APA does not teach or suggest all the limitations recited in amended independent claim 1. Moreover, as discussed above, Carney fails to teach or suggest that which the APA lacks or, alternatively, is nonanalogous art and, thus, may not be

relied upon to maintain a rejection under 35 U.S.C. § 103. Further, the Applicant respectfully asserts that Parvathaneny does not teach or suggest all the limitations recited in independent claim 1 as well as dependent claims 4 and 5, for the reasons as previously discussed in the Response to Office Action mailed July 12, 2004 and incorporated herein by reference. In view of the above, the rejection under 35 U.S.C. §103 cannot be maintained. Accordingly, withdrawal of this rejection is respectfully requested.

#### Claims 6 and 8

Claims 6 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Admitted Prior Art (APA) in view of Carney and further in view of U.S. Patent No. 6,708,181 ("Peterson"). Claim 6 has been cancelled by this reply. Accordingly, the rejection is now moot with respect to claim 6. Claim 8 depends from amended independent claim 1. To the extent that this rejection still applies to the amended claim, this rejection is respectfully traversed.

The Examiner has admitted that the APA does not teach or suggest all the limitations recited in amended independent claim 1. Moreover, as discussed above, Carney fails to teach or suggest that which the APA lacks or, alternatively, is nonanalogous art and, thus, may not be relied upon to maintain a rejection under 35 U.S.C. § 103. Further, Peterson does not teach that which the APA and Carney lack. This is evidenced by the fact that Peterson is only relied upon to teach "class initialization" methods. In view of the above, the rejection under 35 U.S.C. §103 cannot be maintained. Accordingly, withdrawal of this rejection is respectfully requested.

#### Claim 9

Claim 9 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Admitted Prior Art (APA) in view of Carney and further in view of U.S. Patent No. 6,110,227 ("Marcelais").

Claim 9 depends from amended independent claim 1. To the extent that this rejection still applies to the amended claim, this rejection is respectfully traversed.

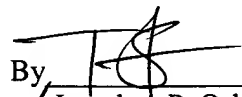
The Examiner has admitted that APA does not teach or suggest all the limitations recited in amended independent claim 1. Moreover, as discussed above, Carney fails to teach or suggest that which the APA lacks or, alternatively, is nonanalogous art and, thus, may not be relied upon to maintain a rejection under 35 U.S.C. § 103. Further, Marcelais does not teach that which the APA and Lindsay lack. This is evidenced by the fact that Marcelais is only relied upon to teach a "command enabling reading." In view of the above, the rejection under 35 U.S.C. § 103 cannot be maintained. Accordingly, withdrawal of this rejection is respectfully requested.

### Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/003001).

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Respectfully submitted,

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